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PATENT

Attorney Docket No. 020375-006500US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Jeffrey G. Nowlin et al.

Application No.: 10/028,888

Filed: December 19, 2001

For: WEIGHT MEASURING SYSTEMS
AND METHODS

Examiner: Richard S. Woo

Art Unit: 3629

APPELLANTS' BRIEF UNDER 37 CFR
§1.192

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REAL PARTY IN INTEREST

All right, title and interest in the subject invention and application are assigned to
First Data Corporation, 6200 South Quebec Street, Greenwood Village, CO 80111.

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RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or are directly affected by, or have a bearing on the board decision of the pending appeal.

STATUS OF CLAIMS

Claims 1-26 were originally presented in the application. Claims 3, 5, 17, and 23 through 26 have been cancelled, and claims 27 through 35 have been added. Thus, claims 1, 2, 4, 6 through 16, 18 through 22, and 27 through 35 remain pending, and all such pending claims are rejected and are the subject of this appeal. A copy of the pending claims, with an indication of the status of each claim as of this appeal, is provided in Appendix A, attached hereto.

STATUS OF AMENDMENTS

An Amendment After Final Rejection under 37 CFR 1.116 (dated September 26, 2003) was filed, presenting arguments but making no amendments to the claims. Such Amendment After Final Rejection was considered by the Examiner, but was not deemed by the Examiner to put the application in condition for allowance.

SUMMARY OF THE INVENTION

The present invention relates to a system and corresponding method for assembling and weighing a mailing unit formed from a plurality of components, such as mail inserts and envelopes. In one embodiment, as represented by claim 1, the method includes determining and electronically storing the weight of each component in memory, and printing an identifier (e.g., bar code) on one of the components. The identifier is read in order to identify the components of the mailing unit and to place the inserts into the envelope. The total weight of the mailing unit is determined based on the individual component weights stored in memory. In an embodiment described in the specification at paragraphs 24 through 26, a system 100 and its corresponding method provide a printer 110 for printing the identifier on a component (such as card carrier) at the system (rather than being pre-printed elsewhere). The identifier is read at a reader (unit 116), and the system then assembles the components, places them in the envelope and determines the overall weight based on the printed identifier. As disclosed (paragraphs 24 through 26) and as recited in each of the claims, the identifier is printed on a component (e.g., card carrier) within the system 100 after such component is provided to the system 100. Such an

arrangement provides readily appreciated advantages of flexibility to the system and method (e.g., not having to arrange pre-printing of the identifier on components, and being able to change the nature of the identifier at the system as circumstances dictate).

ISSUES

The Examiner rejected the claims on three different grounds in the Final Office Action, dated August 12, 2003. Such rejections provide the bases for the three issues on appeal:

(1) Whether claims 1, 2, 4, 6 through 8, 10, 12, 15, 16, 18 through 21, 27, 28, and 30 through 32 are anticipated under 35 U.S. 102(b) by **Long** (EP Publication No. 0,621,563)?

(2) Whether claims 1, 2, 4, 7, 9, and 12 through 14 are unpatentable under 35 U.S.C. 103(a) over **Delfer** (U.S. Patent No. 5,264,665) in view of **Long**?

(3) Whether claims 11, 22, 29 and 33 through 35 are unpatentable under 35 U.S.C. 103(a) over **Long** in view of **Delfer**?

GROUPING OF THE CLAIMS

For each ground of rejection that appellant contests herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

ARGUMENT

Issue 1: Whether claims 1, 2, 4, 6 through 8, 10, 12, 15, 16, 18 through 21, 27, 28, and 30 through 32 are anticipated under 35 U.S. 102(b) by **Long** (EP Publication No. 0,621,563)?

Appellants believe that the subject matter of claims 1, 2, 4, 6 through 8, 10, 12, 15, 16, 18 through 21, 27, 28, and 30 through 32 is not anticipated by **Long** as argued by the Examiner in the Final Office Action.

Long discloses a mailing system where information is printed on a web of paper 14, after the web of paper is provided to the system. Such information (which the Examiner refers to as an "identifier") is name, address and other information printed on the web of paper 14 for purposes of producing a letter or similar insert (see, e.g., col. 6, lines 17 through 23 of **Long**).

As is well established, a claim is anticipated only when "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See* MPEP Section 2131 and Verdegaal Bros. v. Union Oil Company of California, 814 F. E2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). In connection with the present claims, each of the independent claims 1, 15, 27 and 31 recite a novel combination of elements not disclosed in **Long**. For example, in claim 1, there is recited "printing at the system an identifier on one of the components forming the mailing unit *after that one of the components has been provided to the system*, wherein the identifier may be used *in identifying the components* of the mailing unit" and "reading the identifier to determine the components of the mailing unit" (emphasis added). Similar limitations appear in the other independent claims

The Examiner has apparently not fully considered such limitations in his arguments for rejecting the claims. For example, in the remarks to the Final Office Action (page 3, concerning claims 1, 15, 27 and 31), the Examiner states that **Long** discloses "printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper" and "reading the identifier to determine the components of the mailing unit". Such a characterization of **Long** is not correct. The printed identifier or information in **Long** referenced by the Examiner is clearly not printed in order to later identify components of the mailing unit. Further, there is no step (or corresponding system elements) in **Long** for reading that identifier to determine the mailing components. To the contrary, the "identifier" (i.e., the information such as name and address) that is printed on the web of paper 14 in **Long** is solely for purposes of producing a letter or similar insert (see, e.g., col. 6, lines 15 through 23 of **Long**).

As Appellants pointed out in their Amendment After Final Rejection, there is, in fact, an "identifier" in **Long** that is used to determine the components of the mailing unit. However, that identifier is the data record stored on each credit card 32, which identifier is necessarily printed (or stored) on the credit card before the card is provided to the system (in this connection, see col. 3, lines 5 through 8, and col. 5, lines 42 through 49 of **Long**).

Accordingly, **Long** does not show each and every element in the independent claims 1, 15, 27 and 31 (and the other rejected claims that are all dependent therefrom), and thus such claims are not anticipated by **Long**.

Issue 2: Whether claims 1, 2, 4, 7, 9, and 12 through 14 are unpatentable under 35 U.S.C. 103(a) over **Delfer** (U.S. Patent No. 5,264,665) in view of **Long**.

Delfer shows a system for electronically storing weight information concerning mail inserts, and using that stored information as part of a postal qualification and mailing process. **Delfer** clearly does not show or suggest by itself Appellants' invention. The Examiner combines **Long** with **Delfer** and states that **Long** teaches printing an identifier on a traveling web of paper, and then reading the identifier to determine the components of the mailing unit (see page 7 of the remarks in the Final Office Action).

However, **Long** clearly does not teach or show the elements as argued by the Examiner. As noted earlier, **Long** does not show printing an identifier at the mailing system that is subsequently read at the mailing system to determine the components of a mailing unit. The "identifier" referred to by the Examiner is the information printed on the web of paper 14 for purposes of producing a letter or similar insert. It is not subsequently read in order to identify mailing components. As also noted earlier, there is an identifier in **Long** that is read in order to determine mailing components, namely the data record that is stored on each credit card 32 before the card is provided to the system. While the Examiner does not discuss this data record as an identifier in his remarks, Appellants believe that this data record or identifier actually teaches away from the present invention (as embodied in claim 1 as well as claims 2, 4, 7, 9, and 12 through 14 depending therefrom), since it is pre-printed (stored or printed before being provided to the system), and thus does not provide the flexibility that is provided by Appellants' invention.

If one were to combine **Delfer** and **Long** as suggested by the Examiner, it would teach a mailing system and method (1) where weight and thickness data for mail inserts are stored electronically in advance for use in presorting mailing units and later printing labels for the grouped mailing units, as taught by **Delfer** (e.g., see col. 4, lines 54 through 56, col. 4, line 59 through col. 5, line 3, col. 4, lines 10 through 28, and col. 6, lines 16 - 36), and (2) combined with an identifier that is pre-printed or stored in advance on a card and then read by the system to determine the mailing components and to subsequently print information (e.g., names, addresses, and so forth, as part of a letter), as taught by **Long**. Such is clearly not Appellants' invention in

claim 1, where an identifier (e.g., bar code) is printed on an insert *after* provided to the system 100, and *that identifier* is then read at the system to identify the components (inserts, envelopes) of the mailing unit.

Under this rejection, the Examiner also rejects various dependent claims (2, 4, 7, 9, and 12 - 14). Such dependent claims recite further limitations in combination with those in claim 1, such as:

using the printed identifier to sum component weights prior to or during assembly (claims 2 and 4);

grouping inserts along a track and selecting inserts from the groups (claim 7);
the inserts being advantageously used for mailings of financial statements and other recited categories (claims 9 and 12);

and organizing the mailing units by weight classification and then marking those units that are different in their weight than their classification (claims 13 and 14).

The combination of such further limitations with the novel identifier of claim 1 is clearly not suggested either by **Delfer** or **Long**.

Issue 3: Whether claims 11, 22, 29 and 33 through 35 are unpatentable under 35 U.S.C. 103(a) over **Long** in view of **Delfer**?

This issue relates to the third grounds for rejection made by the Examiner, and while it is not made to the same claims as in Issue 2, the Examiner bases the rejection on the same two references (**Long** and **Delfer**), but in reverse order. Appellants have tried to determine whether that reverse order is meaningful in distinguishing the two different grounds of rejection -- it does not appear to be.

Regardless of whether such order is meaningful or not, Appellants believe the same arguments as stated above in Issue 2 (as pertains to independent claim 1) are applicable to the rejection of these claims -- specifically that **Long** and **Delfer** as combined do not teach a mailing system and method having the novel identifier of Appellants' invention, namely a system and method where an identifier (e.g., bar code) is printed on an insert *after* provided to the system, and *that identifier* is then read at the system to identify the components (inserts,

envelopes) of the mailing unit. This limitation is incorporated in each of the claims 11, 22, 29 and 33 through 35.

The rejected claims (11, 22, 29, and 33 through 35) also recite various limitations in addition to printing and reading of the novel identifier as just noted.

In claim 11 there is recited, in addition to the previously referenced identifier, the further limitations of the inserts comprising a financial statement and a card carrier, with the identifier being printed on the card carrier. Nowhere in **Delfer** or **Long** is there a teaching of such an identifier being printed on a card carrier or any other kind of "financial statement". The Examiner's comments (page 8 of the remarks in the Final Office Action) in connection with claim 11 are not fully understood. However, if they are intended to mean that the mere presence of a financial statement (e.g., the billing statement as described at col. 4, line 12 of **Delfer**) or a card carrier (e.g., the web section having the affixed card as described at col. 5, line 5 in **Long**), which happens to have information printed thereon, teaches the printing of Appellants' novel identifier on a card carrier, such a teaching is no where to be found in either reference.

Claims 22, 29 and 33 recite, among other things, that the novel identifier is combined with various additional limitations such as a marking system, the novel identifier being printed on a financial statement, and identifying a customer and a plurality of other inserts to be inserted with the financial statement. Such combinations are not shown or taught by combining **Long** and **Delfer**.

Further, as to claims 34 and 35, there is recited a second printer (in addition to the printer for printing of the identifier on the first insert) that prints a second identifier. The Examiner argues (page 9 of the Remarks in the Final Office Action) that although the second printer is not shown in either **Long** or **Delfer**, such additional structure would be obvious since it is a "mere duplication of the essential working parts".

Appellants disagree. It is clear from the recited limitations (as well as the disclosed system in the specification) that the second printer is not a duplication of parts. The second printer performs a different function and has a different purpose than the first printer and its identifier. Specifically, the identifier printed by the second printer is not subsequently read in order to identify mailing components. Such purpose is carried out by the first identifier in Appellants' invention.

Further, claims 34 and 35 cannot be reasonably read to infer such a duplication of function, since there is clearly no reason to read and identify inserts twice. As recited in the claims, the second identifier is only based on the first identifier (it is not a duplication of the first identifier), and as disclosed in the specification, the second identifier is used for several purposes different than the first identifier, such as printing a second statement sheet or printing separate pages of checks (see paragraph 31 of the specification). This is clearly not a "mere duplication of the essential working parts."

CONCLUSION

Appellants believe that the above arguments are fully responsive to all grounds of rejection set forth in the Final Office Action dated August 12, 2003. Please deduct the requisite fee, pursuant to 37 CFR § 1.17(c), of \$330 from deposit account 20-1430 and any additional fees associated with this Brief. This Brief is submitted in triplicate.

Respectfully submitted,



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